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OFFICE OF PETITIONS

In re Application of
Sami Nemi
Application No. 09/853,602
Filed: May 14, 2001
Atty Docket No. 08806.0010-00

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: DECISION ON APPLICATION
: FOR
: PATENT TERM ADJUSTMENT
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This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT - PRE-GRANT," filed August 4, 2005. Applicant requests that the patent term adjustment indicated in the Notice of Allowance be corrected from four hundred forty-seven (447) days to three hundred ninety-nine (399) days.

The request for reconsideration of the patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred sixty-seven (367)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 6, 2005, the Office mailed the Notice of Allowance with a Patent Term Adjustment of 447 days. On August 4, 2005, applicant timely¹ filed the instant application for patent term adjustment. The applicant points out that the Office mailed a non-final rejection on December 19, 2003 (not April 1, 2004 as indicated on the PAIR screen) thereby reducing the adjustment stated with the Notice of Allowance. Additionally, applicant argues that the 32-day reduction be corrected to 0 days as applicant's amendment, filed on September 2, 2005, was filed in response to the Final Office Action and was filed within the three-month period set forth in § 1.704(b). Applicant states that the reduction of 32 days associated with the second response, a Notice of Appeal, is improper. Applicant maintains that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified application, as set forth in 37 C.F.R. § 1.704(b).

Applicant discloses that this application is subject to a terminal disclaimer.

Applicant is correct that a period of adjustment of 80 days for Office delay should not have been entered. A review of the

¹ PALM records indicate that the Issue Fee payment was received on August 11, 2005.

record confirms that in response to, and within four months of filing of the response filed September 12, 2003, the Office mailed a non-final Office action on December 19, 2003 (not April 1, 2004). Thus, in association with responding to the response filed September 12, 2003, there was no Office delay within the meaning of 1.703(a)(2). (It is further noted that applicant filed a response to the non-final Office action on March 19, 2004, within three months of the mailing of the Office action).

However, applicant is incorrect with respect to the reduction of 32 days for applicant's filing of a Notice of Appeal on October 4, 2004. This reduction is proper pursuant to § 1.704(b). As the amendment filed September 2, 2004, was not in compliance with § 1.113(c), the period for reply to the final rejection mailed June 2, 2004, continued to run. See Advisory Action mailed October 12, 2004. The proper reply, a Notice of Appeal, was not received in the Office until October 4, 2004. Accordingly, the reduction began September 3, 2004, the day after the date that is three months after the date of mailing of the final rejection, and ended October 4, 2004, the date the Notice of Appeal was filed. Thus, the period of reduction of 32 days is correct.

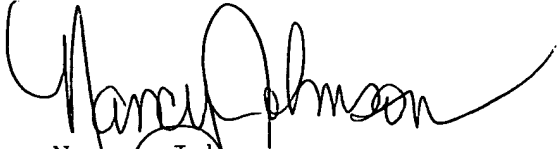
In view thereof, the patent term adjustment at the time of the mailing of the Notice of Allowance is THREE HUNDRED SIXTY-SEVEN (367) days (399 - 32)..

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is, thereby, forwarded to the Publishing Division for processing into a patent. The patent term adjustment indicated on the patent will include any additional patent term accrued for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, as well as, any additional patent term accrued for the Office taking in excess of three years to issue the patent².

² Applicants are reminded that: If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). As 522 days have already been entered for grounds specified in § 1.702(a)(1) and § 1.702(a)(2), no additional patent term will be entered for the Office taking in excess of three years to issue the patent unless the number of days of delay exceed 522 days.

Telephone inquiries specific to this matter should be directed to the undersigned, at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petition

Enclosure: Copy of REVISED PAIR Screen